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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,747	01/10/2000	MITCHELL REID	SILA:054	4684

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EXAMINER
MUNOZ, GUILLERMO

ART UNIT	PAPER NUMBER
2634	13

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/480,747	REID ET AL.	
	Examiner	Art Unit	
	Guillermo Munoz	2634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *amendment filed on June 30, 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-9,18,23-25,30 and 36-39* is/are rejected.

7)☒ Claim(s) *5,10-17,19-22,26-29,31-35 and 40-46* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *30 June 2003* is: a)☐ approved b)☒ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

The drawings filed on June 30, 2003 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6-9, 18, and 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 43 (as numbered in Amendment filed May 28, 2003) of recently allowed U.S. Patent Application 09/480,058. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application broaden the limitations claimed in the respective claims of U.S. Patent Application 09/480,058.

Claim 43 of U.S. Patent Application 09/480,058 discloses the following:

- "the system-side line isolation integrated circuit including a digital-signal processor (DSP) having a modem processor" in claim 43, lines 4-5.

The modem processor meets the limitation of providing modem circuitry in claim 1, line 2 of the instant application.

The system-side line isolation integrated circuit meets the limitation of providing system side line isolation circuitry in claim 1, line 3 of the instant application.

- "processing the digital data transmitted or received across the capacitive isolation barrier with the digital signal processor within the system-side line-isolation integrated circuit" in claim 43, lines 6-7.

The digital signal processor within the system-side line-isolation integrated circuit receiving digital data across the capacitive isolation barrier meets the limitation of integrating the modem circuitry and system side line isolation circuitry within a single integrated circuit, the single integrated circuit configured to communicate through an isolation barrier in claim 1, lines 4-6 of the instant application.

The digital signal processor within the system-side line-isolation integrated circuit meets the limitation of modem circuit integrated with a system side line isolation circuit in claim 7 of the instant application.

The digital data transmitted across the capacitive isolation barrier meets the limitation of system side line isolation circuit being configured to transfer data across an isolation barrier in claim 8 of the instant application.

The digital data received across the capacitive isolation barrier meets the limitation of transmitting data from the external circuit to the modem circuitry in claim 18 of the instant application.

The digital signal processor within the system-side line-isolation integrated circuit meets the limitation of modem circuit integrated with a system side line isolation circuit in claim 23, line 3 of the instant application.

The digital data transmitted across the capacitive isolation barrier meets the limitation of system side line isolation circuit being configured to transfer data across an isolation barrier in claim 24 of the instant application.

- "communicating through an asynchronous serial interface with an external integrated circuit" in claim 43, line 10.

The asynchronous serial interface meets the limitation of providing an asynchronous serial port on the single integrated circuit, the asynchronous serial port being configured to communicate with a system-side external circuit in claim 1, lines 7-8 of the instant application.

The asynchronous serial interface meets the limitation of using the asynchronous serial pin to transfer the data formatted with the synchronous modem transmission protocol between the modem circuit and an external circuit through the asynchronous serial pin in an asynchronous manner in claim 6, lines 5-7 of the instant application.

The external integrated circuit meets the limitation of claimed transmitting data from modem circuitry to the external circuit in claim 9 of the instant application.

The asynchronous serial interface meets the limitation of providing the integrated modem and system side line isolation circuit with an asynchronous serial pin in claim 23, line 4-5 and using the asynchronous serial pin to transfer the data formatted with the synchronous modem transmission protocol between the modem circuit and a system-side external circuit through the asynchronous serial pin in claim 23, lines 8-10 of the instant application.

- "selectively configuring the system-side line isolation integrated circuit to transfer data of a synchronous modem transmission protocol through the asynchronous serial interface" in claim 43, lines 16-17.

The system-side isolation circuit configured to transfer data of a synchronous modem transmission protocol through the asynchronous serial interface meets the limitation of configuring the single integrated circuit to use the asynchronous serial port to transfer data formatted with a synchronous modem transmission protocol between the single integrated circuit and the system-side external circuit through the asynchronous serial port in claim 1, lines 9-11 of the instant application.

The system-side isolation circuit configured to transfer data of a synchronous modem transmission protocol through the asynchronous serial interface meets the limitation of providing data formatted with a synchronous modem transmission protocol to an asynchronous serial pin of a modem circuit in claim 6, lines 3-4 of the instant application.

The system-side isolation circuit configured to transfer data of a synchronous modem transmission protocol through the asynchronous serial interface meets the limitation of

providing data formatted with a synchronous modem transmission protocol to the asynchronous serial pin in claim 23, lines 6-7 of the instant application.

Claims 2 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 60 (as numbered in Amendment filed May 28, 2003) of recently allowed U.S. Patent Application 09/480,058. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application broaden the limitations claimed in the respective claims of U.S. Patent Application 09/480,058.

Claim 60 of U.S. Patent Application 09/480,058 discloses the following:

- "the synchronous modem transmission protocol is an HDLC protocol" in claim 60.

The HDLC protocol meets the limitation of synchronous modem transmission protocol is an HDLC protocol in claims 2 and 25 of the instant application.

Claims 3-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 51 (as numbered in Amendment filed May 28, 2003) of recently allowed U.S. Patent Application 09/480,058. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application broaden the limitations claimed in the respective claims of U.S. Patent Application 09/480,058.

Claim 51 of U.S. Patent Application 09/480,058 discloses the following:

- "providing a plurality of user program input/output pins for the system-side line-isolation integrated circuit" in claim 51, lines 1-2.

The output pins meet the limitation of serial port is a transmit pin of the single integrated circuit in claim 3 of the instant application. The input pins meet the limitation of serial port is a receive pin of the single integrated circuit in claim 4 of the instant application.

Claims 30, 37, and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 (as numbered in Amendment filed May 28, 2003) of recently allowed U.S. Patent Application 09/480,058. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application broaden the limitations claimed in the respective claims of U.S. Patent Application 09/480,058.

Claim 24 of U.S. Patent Application 09/480,058 discloses the following:

- "digital signal processing (DSP circuitry included within the system-side line-isolation integrated circuit, the DSP circuitry having a modem processor for modem data and a digital processor for system-side circuitry" in claim 24, lines 7-9.

The digital signal processor within the system-side line-isolation integrated circuit meets the limitation of an integrated modem and line-isolation circuit in claim 30, line 3 of the instant application.

The digital signal processor within the system-side line-isolation integrated circuit meets the limitation of a modem circuitry and system side line isolation circuitry integrated within the line isolation circuit in claim 37, lines 2-3 of the instant application.

- "an asynchronous serial communication interface port capable of connecting to an external system-side integrated circuit" in claim 24, lines 4-5.

The asynchronous serial communication interface port meets the limitation of an asynchronous serial pin, the asynchronous serial pin being an input or output pin of the integrated modem and line-isolation circuit in claim 30, lines 4-5 of the instant application.

The asynchronous serial communication interface port meets the limitation of an asynchronous serial interface pin coupled to the modem circuitry and the system side line isolation circuitry in claim 37, lines 4-5 of the instant application.

- "wherein the system-side circuitry is configurable to transfer data formatted with a synchronous modem transmission protocol through the asynchronous serial communication interface port" in claim 24, lines 13-15.

The system-side circuitry configured to transfer data formatted with a synchronous modem transmission protocol through the asynchronous serial communication interface port meets the limitation of means to enable use of the asynchronous serial pin to transfer of data formatted with the synchronous modem transmission protocol between the integrated modem and line-isolation circuit and an external circuit through the asynchronous serial pin in claim 30, lines 6-8 of the instant application.

The system-side circuitry configured to transfer data formatted with a synchronous modem transmission protocol through the asynchronous serial communication interface port meets the limitation of integrated line isolation circuit configured to use the asynchronous serial interface pin to transfer data formatted with a synchronous modem transmission protocol between the line isolation circuit and a system-side external circuit through the asynchronous serial interface pin in claim 37, lines 5-8 of the instant application.

- "a system-side line-isolation integrated circuit capable of being coupled to a capacitive isolation barrier to communicate digital information through the capacitive isolation barrier" in claim 24, lines 2-3.

The system-side line-isolation integrated circuit capable of communicating digital information through a isolation barrier meet the limitation of isolation circuit configured to transfer data across an isolation barrier in claim 38 of the instant application.

Claims 36 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 42 (as numbered in Amendment filed May 28, 2003) of recently allowed U.S. Patent Application 09/480,058. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application broaden the limitations claimed in the respective claims of U.S. Patent Application 09/480,058.

Claim 42 of U.S. Patent Application 09/480,058 discloses the following:

- "synchronous modem transmission protocol being a framed HDLC protocol" in claim 42.

The synchronous modem transmission protocol being a framed HDLC protocol meets the limitation of synchronous modem transmission protocol being an HDLC framing protocol in claim 36 of the instant application.

The synchronous modem transmission protocol being a framed HDLC protocol meets the limitation of synchronous modem transmission protocol being an HDLC framing protocol in claim 39 of the instant application.

Claim Objections

Claims 5, 10-17, 19-22, 26-29, 31-35, and 40-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guillermo Munoz whose telephone number is 703-305-4224. The examiner can normally be reached on Monday-Friday 8:30a.m-4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on 703-305-4714. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9313 for regular communications and 703-872-9313 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Guillermo Munoz

GM
September 8, 2003

STEPHEN CHIN
SUPERVISORY PATENT EXAMINER
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